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09/840,488	04/23/2001	Klaus-Juergen Pees	33350-03	5506

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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 20040511

Application Number: 09/840,488
Filing Date: April 23, 2001
Appellant(s): PEES ET AL.

Jason D. Voight
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/22/2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 3/22/04 has not been entered. Insofar as the claims are concerned, this has no bearing on the issues, since the sole amendment to the claims in that paper was correcting an insignificant spelling error.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-9 stand or fall together for the 35 USC 102 rejection because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

Appellant's brief includes a statement that claims 1-8 and 9 do not stand or fall together insofar as the 35 SUC 112 rejection, and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

A substantially correct copy of appealed claims 1-9 appears on page 8-9 of the Appendix to the appellant's brief. The minor error is as follows: The minor typographical error in claim 9 was not fixed but is of no important here.

(9) Prior Art of Record

5981534 Pfrengle 11-1999

(10) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

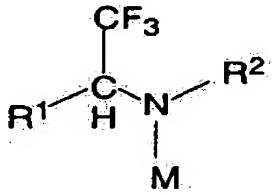
ANTICIPATION REJECTION

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by 5981534. For example the third species in Table I is the same as the last species in claim 5.

There is no real disagreement as to the facts or even the law here, but rather one of procedure. In order to antedate the reference, appellants need to get benefit of an application which was not mentioned in the parent. Appellants have attempted to solve this problem by filing a reissue application of the parent to this case. This reissue filing was done at about the time of the filing of the Notice of Appeal in this case, so no determination has yet been made. But without benefit of the provisional priority date, this is still a proper reference. Appellants' arguments is basically that since they are going to be successful in the reissue, the rejection should be dropped. There is no merit to this approach.

EANBLEMENT REJECTION

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the other metals, does not reasonably provide enablement for Zinc. M = Zn is impossible. Formula III, the reactant, is as follows:



(III)

Formula III calls for a metal in the valence state of +1, since the amino part of the molecule carries a charge of –1. The formula clearly shows one amine and one metal. Unlike the other metals of claim 9, Zn does not have a valence state of +1. Zn cannot form a molecule of Formula III as a result.

It is a little difficult to tell exactly what appellants are arguing here in response. On the one hand, appellants state, "The preparation of a compound (III) wherein M represents Zn is well known." But on the other hand appellants state that a reasonable person "would not attempt to produce a compound (III) wherein M represents Zn in the valence state +1." It is not easy to reconcile these two statements, since compound (III) clearly depicts a metal in the valence state +1.

The only hint of how appellants reconcile such seeming contradictions is this (fifth from last line of page 5 of Appeal Brief): "The mere fact that formula (III) appears to call for a metal having a valence state of +1...." This is repeated on page 6, last paragraph before the conclusion, where "appears" is in italics. The use of "appears" in these two sentences seems to imply that appellants don't think that the formula does call for a valence state of +1, but only "appears" to. However, the Appeal Brief is somewhat coy on the subject, not coming right out and saying that it is not +1. The closest is this from page 6: "A reasonable person of ordinary skill in the art would, therefore, not interpret appellants' formula (III) as requiring the presence of Zn in a valence state of +1." This is unpersuasive for two reasons. First, Formula III does not require any interpretation at all. It is perfectly clear and unambiguous, and for the other metals, not problematic. It is simply impossible for Zn because unlike the other metals,

Zn does not have a +1 state. And second, while appellants say this is the wrong way to "interpret" the claim, they do not state what is the right way to "interpret" the claim. Instead, appellants argue that the valence state is somehow not "critical or even significant". But if the reagent is not possible to exist, that would certainly be significant.

There are some arguments based on a "Jerry March" reference, but such reference is not of record and will not be considered.

There are basically five possibilities here for the Formula III.

A. The formula is right, because that somehow a Zn(I) compound has uniquely been made here. The brief, however, seems to reject that approach.

B. There may have been a typographical error; instead of Zn there was intended In. Indium does form the valence state +1.

C. The wrong metal may have appeared. Since the metal after Zn is Cu, perhaps Ag was intended. Since the metal before Zn was K, perhaps Rb was intended.

D. The wrong stoichiometry may appear; the formula should have two amine anions for the Zn, not just one.

E. The Zn should have been coupled with e.g. a halide. Thus, if the claim had M as ZnCl rather than Zn, that would have a net charge of +1 and solve the problem.

Appellants should have figured out what the error was and fixed it. An error can be corrected provided that there is not "reasonable debate" as to what the correct text would be, *Novo Industries, L.P. vs. Micro Molds Corp.*, 350 F.3d 1348, 69 USPQ2d 1128 (2003). Here, clearly there is more than one possibility, as was the case in *Novo Industries* as well. In such a case, one must show that one of ordinary skill in the art

would have been able to determine for sure what was intended, *Ex parte Brodbeck*, 199 USPQ 230. Failing that, Zn should have been removed.

As it stands, however, Formula III is not enabled because such a reagent cannot exist in the first place.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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May 11, 2004

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